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IN THE

Supreme Court of the United States

OCTOBER TERM, 1977

No. 77-1198

A. M. NAMIROWSKI,
Petitioner,

vs.

NABISCO, INC., a foreign corporation,
Respondent.

BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT

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The five claims of petitioner's patent were all declared invalid by the District Court on motion for summary judgment. The District Court's opinion (Pet. App. 14-24) was affirmed and adopted by the Court of Appeals.

Four of the claims of petitioner's patent (numbers 1, 2, 3, and 5) were invalidated under 35 U.S.C. Sec. 102 (a) and (b), since they were fully anticipated by prior art. This prior art was exemplified by the 1939 British Patent No. 507,931 to Vicars, which discloses every element of claims 1, 2, 3, and 5, and every element of claim 4 except the blower. Undisputed evidence shows that the prior art exemplified in Vicars was also embodied in several machines in operation long before the date of petitioner's alleged invention. The Vicars patent had the

same purpose and result as that alleged in petitioner's patent—to keep excess salt out of the baking oven (Pet. App. 20, 21).

The remaining claim 4 added another element to the combination described in the other claims—the fixed positioning of a blower just before the biscuits would enter the oven. The undisputed evidence showed that the use of a detached blower for the same purpose was common and well known in the art prior to petitioner's alleged invention. The District Court held that, in light of the prior art, the rearrangement of a blower in a fixed position where it performed the same function it had previously performed, rather than leaving it detached, was obvious and hence claim 4 was invalid.

The Court of Appeals, after briefs and oral arguments, summarily affirmed the District Court for the reasons set forth in the latter's decision. In doing so, the Court of Appeals invoked its own Rule 35 (Pet. App. 10-13).

Petitioner requests a review of the decision of the Courts of Appeals on three grounds.

First, petitioner claims that Circuit Rule 35 or the Order entered in this case pursuant to said Rule, are unconstitutional because either one or both allegedly violates the due process and equal protection provisions of the Constitution and, according to petitioner, either one or both violates the orderly administration of justice and appellate procedure.

Second, petitioner claims that the District Court erred in deciding that petitioner's patent was not entitled to a presumption of validity and that this determination undermined the grant of summary judgment.

Third, petitioner claims that summary judgment should not have been granted because the *Graham* and *Sakraida* decisions precluded it and the District Court, sanctioned

by the Court of Appeals, ignored the demands of those decisions and ignored the basic requisites underlying summary judgment.

I. CIRCUIT RULE 35 AND THE ORDER ENTERED IN THIS CASE UNDER IT ARE CLEARLY VALID

Circuit Rule 35 and the Order entered in this case pursuant to it are clearly constitutional and promote the orderly administration of justice and appellate procedure.

The provisions of Circuit Rule 35 are entirely consistent with the Federal Rules Of Appellate Procedure (FRAP) adopted by Order of this Court on December 4, 1967 and as amended by the various Orders of this Court since that time. FRAP Rule 36 clearly provides for the entry of judgment "without an opinion" by the clerk of the Court of Appeals and directs the clerk to mail "the judgment if no opinion was written" to all parties. In its Recommendation and Report to the April 1972 Session of the Judicial Conference of the United States on the Publication of Courts of Appeals Opinions (Resp. App. 1), the Board of the Federal Judicial Center reported (in 1972):

> "Ten years ago there were estimates that published decisions of American courts approached two and a half million. Today it probably is nearer three million. *Common law in the United States could be crushed by its own weight if this continues unabated.*" (emphasis added)

Subsequent to this Report and Recommendation, all circuits adopted rules providing for unpublished decisions and most circuits adopted rules prohibiting the citation of such decisions in other cases.

Circuit Rule 35 was duly made by a majority of Judges of the Seventh Circuit Court of Appeals.

The Order of the Court of Appeals under Circuit Rule 35 finding petitioner's patent invalid specifically adopted the opinion of the District Court (Pet. App. 2). By so doing, it provided the specificity, the lack of which petitioner contends obstructed his right to prepare and file the Petition for Writ now before this Court.

Furthermore, the Order speaks for itself and clearly falls at least under provisions (c) (2) (ii) of Circuit Rule 35 relating to appeals concerning the application of recognized rules of law and presenting arguments which are sufficiently substantial to warrant explanation but are not of general interest or importance. However, Circuit Rule 35 also speaks for itself and it would be superfluous for the rule to require the Court of Appeals to designate in its Order pursuant to the rule the category under which the Order is issued.

The absence of a requirement to designate category did not preclude petitioner from filing a motion for rehearing before the Court of Appeals since both the Order and the Rule under which it was issued were provided to petitioner well within the period for making such motions in this case. As the record shows, petitioner made no motion for rehearing before the Court of Appeals.

This Court, in *Taylor* v. *McKeithen*, 407 U.S. 191, 92 S.Ct. 1980 (1972), has approved the practice of using judgment orders: "We of course, agree that the courts of appeals should have wide latitude in their decisions of whether or how to write opinions. That is especially true with respect to summary affirmances." (407 U.S. 194 at note 4, 92 S.Ct. 1982). The practice has also been approved by the Fifth Circuit Court of Appeals in *NLRB* v. *Amalgamated Clothing Workers of America*, 430 F.2d 966 (1970), and the Third Circuit Court of Appeals in *United States* v. *Baynes et al.*, 548 F.2d 481 (1977).

Circuit Court Rule 35 and the Order issued under it in this case do not diminish or otherwise adversely affect

the doctrine of stare decisis. The opinion of the District Court appears at 421 F.Supp. 349, and stands affirmed by the Court of Appeals. The considered judicial opinion of the three Judges comprising the Court of Appeals panel that heard and affirmed the appeal from the District Court obviously was that there was no real need for a written opinion at all, the law would receive no benefit from any discussion of the evidence which was held to be insufficient to create a genuine issue of fact, and an opinion would have no precedential value since the principles of law were well established. Petitioner's suggestions that the Court of Appeals has buried its decision, has avoided accountability, has subjected itself to an "appearance of impropriety" or is a part of "a world of watergates" is temerarious.

II. PETITIONER'S PATENT WAS NOT ENTITLED TO A PRESUMPTION OF VALIDITY

The presumption of validity provided by 35 U.S.C. 282 is intended to presume correctness in the decisions of the United States Patent and Trademark Office (PTO) in its function of issuing patents. The statute provides that a patent shall be presumed valid. As is the case with any presumption, the presumption of validity is rebuttable.

Respondent provided the District Court with invalidating prior art that was not cited and considered by the PTO when it examined and issued petitioner's patent. This invalidating prior art, described above and in the decision of the District Court, included the 1939 British Patent No. 507,931 to Vicars which clearly discloses the basic elements, function and results described and claimed in petitioner's patent and which is far more pertinent than the prior art cited and considered by the PTO when it decided to grant petitioner's patent. The District Court, therefore, was completely justified in finding that there

was no presumption of validity as to petitioner's patent. The Court of Appeals was equally correct in its affirmance.

III. SUMMARY JUDGMENT WAS PROPERLY GRANTED IN THIS CASE

FRCP Rule 56(e) sanctions the rendering of summary judgment if the pleadings, depositions, answers to interrogatories, and admissions on file, together with affidavits, if any, show that there is no *genuine* issue as to any *material* fact and that the moving party is entitled to judgment as a matter of law. Rule 56(e) requires that supporting and opposing affidavits shall be made on personal knowledge, shall set forth such facts as would be admissable in evidence, and shall show affirmatively that the affiant is competent to testify to the matters stated therein.

No different standards are prescribed for summary judgment in cases where a jury demand has been made and logically the standards should be the same. The presence or absence of a jury demand cannot create a genuine issue of material fact where none exists; nor is the jury a competent body to determine questions of law such as whether or not a genuine issue of material fact exists or whether the moving party is entitled to judgment as a matter of law. Petitioner has not been "deprived of a trial by jury" in this case; there simply has been no need for fact finding.

This Court held that summary judgment procedures prescribed by court rules do not infringe the constitutional right of a party to a trial by jury in *Fidelity & Deposit Co. of Maryland* v. *United States*, 187 U.S. 315, 23 S.Ct. 120 (1902). Since promulgation of the Federal Rules of Civil Procedure, the issue of the constitutionality of FRCP Rule 56 has seldom been raised and, when it has been raised, constitutionality has always been sustained. (Moore's Federal Practice, Vol. 6, pages 56-88).

Petitioner does not contest the District Court's summary judgment of invalidity of claims 1, 2, 3 and 5, (Pet. App. 19) nor the affirmance by the Court of Appeals of the judgment below. These claims were invalidated pursuant to 35 U.S.C. 102(a) and (b) on the grounds of prior publications and use, anticipation and lack of novelty, apart from obviousness under 35 U.S.C. 103.

The invalidation of claim 4 as obvious was equally correct. The *Graham* decision by this Court states that commercial success, long felt but unsolved needs, failures of others, etc. "*might*" give light to circumstances surrounding the origin of the subject matter sought to be patented and "*may*" have relevancy as indicia of obviousness or nonobviousness. The later decision by this Court in *Anderson's Black Rock, Inc.* v. *Pavement Salvage Co.*, 396 U.S. 57 (1969) made it quite clear that these matters without invention will not make patentability.

Claim 4 is based on a combination of elements, every one of which was shown to have been old in the art. Reference was made in the *Black Rock* case to the earlier case of *A&P Tea Co.* v. *Supermarket Corp.*, 340 U.S. 147 (1950) where this Court cautioned that: "Courts should scrutinize combination patent claims with a care proportioned to the difficulty and improbability of finding invention in an assembly of old elements."

The District Court in this case carefully followed the principles of these decisions of this Court as well as the *Sakraida* decision and found petitioner's only remaining claim (claim 4—utilizing an air blower for blowing salt from the belt before it enters the oven) to be also invalid as obvious under 35 U.S.C. 103.

The resemblances as well as differences between the present case and the *Sakraida* case decided by this Court in 1976, were recognized by the District Court as justify-

ing the invalidation of petitioner's claim 4. The District Court's initial decision in the *Sakraida* case was to grant summary judgment holding the patent involved invalid. The initial grant of summary judgment in *Sakraida* was, however, not based on prior art patents or publications but was based only on conclusory statements in affidavits and correspondence and, therefore, it was reversed and remanded (437 F.2d 101). The grant of summary judgment in the case at bar is solidly based on a 1939 publication, to wit, the Vicars British Patent and other publications and documents introduced by the supporting affidavits which were made on personal knowledge. These differences are controlling.

In the instant case there were no significant issues of fact concerning the state of the prior art at the time the District Court granted summary judgment. Petitioner before the District Court did not dispute and thus conceded that each element of claim 4 was old and well known in the art prior to petitioner's alleged invention (Pet. App. 22, 23). Petitioner also did not dispute before the District Court, and thus conceded, that each of the old elements in the combination claimed in claim 4 performed its usual well known function and no other, even in the claimed combination. Thus, no genuine issue of material fact existed regarding either the scope and content of the prior art, or differences between the prior art and claims at issues, or the level of ordinary skill in the art.

Petitioner's contention that more or all excess salt is removed by the combination claimed in claim 4 than by prior art combinations is moot, pursuant to the *Sakraida* decision, because combinations of old elements with each performing the same function it had been known to perform, although perhaps producing a more striking result than in previous combinations, are not patentable under standards appropriate for a combination patent.

Except for the slight difference in fact underlying the initial reversal of the grant of summary judgment in the *Sakraida* case, the facts and law of the *Sakraida* decision fit the present case precisely and petitioner's claim 4 was properly invalidated.

On the basis of the foregoing arguments, respondent urges that the Petition for a Writ of Certiorari be denied.

Respectfully submitted,

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APPENDIX

APPENDIX

THE BOARD OF THE FEDERAL JUDICIAL CENTER

Recommendation and Report
to the
April 1972 Session
of the
Judicial Conference of the United States
on the
Publication of Courts of Appeals Opinions

PUBLICATION OF COURTS OF APPEALS OPINIONS

Recommendation

The Judicial Conference should direct that each circuit council should review the publication policy within the circuit and consider the adoption of modifications designed to eliminate unnecessary publication of opinions. Such modifications should include a policy that:

a. Opinions will not be published unless ordered by a majority of the panel rendering decision;

b. Non-published opinions should not be cited, either in briefs or in court opinions;

c. Where an opinion is not published, the public record shall be completed by publishing the judgment of the court.

Further, the Judicial Conference should request that the circuit councils report developments regarding this resolution in one year.

Report

Reducing the number of opinions published in the official reports appears to be a goal so widely shared among the judiciary and the legal community as to require no demonstration by research or formal investigation. The reasons for apprehension over unlimited publication arise from every segment of bench and bar:

a. Unlimited proliferation of published opinions constitutes a burden and a threat to a cohesive body of law. Ten years ago there were estimates that published decisions of American courts approached two and a half million. Today it probably is nearer three million. Common law in the United States could be crushed by its own weight if this continues unabated.

b. Publication of opinions places an extremely heavy burden on the courts. First is the burden of writing opinions. While a limitation on the publication of opinions, in and of itself, does not reduce the number of opinions to be written, it affects greatly the time and resources that must be devoted to opinion preparation. An opinion prepared to inform the parties of the reasons for the decision is quite a different thing from an opinion that will be published and incorporated into the body of precedent. A judge should be able to present his reasoning to the parties without having to acquit his legal scholarship in every opinion. The second burden for the courts is the accountability for consideration of *every* opinion that has *ever* been written.

c. The burden on counsel is commensurate with that of the bench in terms of accountability in preparing their cases. The endless search for factual analogy requires immense expenditure of time and funds that can result in reliance upon quirks rather than careful rationalization and application of the developing law.

d. The logistical burden for courts and practitioners has become dangerously heavy. . . . Posting, maintenance, shelving, and librarian services result in time and money costs disproportionate to the value of the materials.

e. The burden on the publishing industry to continue to supply a complete reporting service at prices that are tolerable.

The Federal Judicial Center has consulted with a number of circuit judges concerning their policies now in effect and their views about the essential elements of a workable method for more effective limitation. The Center also addressed inquiries to several state court systems

known or believed to be applying systematic procedures to publication. From every source, the responses confirm the view that more is being published that is required. Procedures to limit publication range from none at all to the establishment of review bodies external to the courts who decide which opinions to publish and which not. Predictably, those courts with no policy or procedure report little change over the year in the rate of publication; those with review bodies or other fairly restrictive policies report that the ratio of unpublished to published opinions is increasing. The Board has not been convinced on the basis of presently available experience and information that external review boards are necessary or desirable. On the contrary such procedures necessarily entail the establishment of some opportunity for appeal when a judge or panel disagrees with the reviewers. Furthermore, the participation of the writing judge or the deciding panel in the decision not to publish seems likely to assure a more firmly founded policy and greater commitment to it. Accordingly, the Board's recommendation is that the decision to publish be made by those who decide and write.

The Board also recommends that publication policy should embody a presumption against publication. This casts the decision on publication in a positive form, finding that the opinion is one of such general and pervasive significance as to require notice to the legal community and to the public. A decision not to publish does not go to the merits of the opinion but only to the significance of the underlying issues.

Once an opinion has been designated not for publication, it should not be cited as authority either by the court that rendered it or by attorneys appearing before the court. A judge writing primarily for the benefit of the parties is entitled to assume a degree of familiarity with the background of a case, thus enabling him to set

forth only enough to inform the parties of the reasons for the court's decision. An opinion so prepared and directed should not be required to set forth all the material and reasoning which might be necessary for opinions directed to the world at large and intended to enter the body of precedent.

The recommendations urge each circuit to develop and announce a publication policy containing these elements. No attempt has been made here to identify the substantive content standards to guide the publication decision. It is believed that this task can best be performed in each circuit where the body of circuit law is most fully understood. A policy should be designed to enhance the development of each circuit's needs as perceived by the circuit council.

The Advisory Council for Appellate Justice, a group of judges, practitioners and scholars concerned with appellate processes and structures, is now considering the formulation of recommended guidelines for publication of appellate opinions at all levels of court systems throughout the country. The Federal Judicial Center and the National Center for State Courts are working closely with this group. Their report on opinion publication should soon be completed; and the Center will distribute it to all circuit judges for their consideration in developing circuit policy.